

REMARKS

This paper is presented in response to the Office Action. By this paper, claim 25 is added. Claims 1-25 are now pending in the application.

Reconsideration of the application is respectfully requested in view of the following remarks. For the convenience and reference of the Examiner, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

I. General Considerations

Applicant notes that the remarks, or a lack of remarks, herein should not be construed as an acquiescence, on the part of the Applicant: as to the purported teachings or prior art status of the cited references; as to the characterization of the cited references advanced by the Examiner; or as to any other assertions, allegations or characterizations made by the Examiner at any time in this case. Applicant reserves the right to challenge the purported teaching and prior art status of the cited references at any appropriate time.

II. Rejection of Claims 1-24 Under 35 U.S.C. § 103(a)

Applicant respectfully notes at the outset that in order to establish a *prima facie* case of obviousness, it is the burden of the Examiner to demonstrate that three criteria are met: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP* § 2143.

Turning now to the rejections, the Examiner has rejected claims 1-24 under 35 U.S.C. § 103(a) as being unpatentable over US Pub. No. 2003/0091304 to Tonai et al. ("*Tonai*") in view of US 6,663,296 to Blair et al. ("*Blair*"). Applicant respectfully disagrees however and submits that for at least the reasons outlined below, the rejection of claims 1-24 should be withdrawn.

In rejecting the claims, the Examiner concedes that *Tonai* does not disclose "... the first facet of the optical component being parallel to the second facet of the optical component," but goes on to assert that "*Blair* et al. shows a similar optoelectronic module comprising an optical component 35 having a first and second facet parallel to one another, and the terminal end of optical fiber contacts the first facet of the

optical component ...” The Examiner further asserts that “Blair teaches that the optical component substantially reduces and suppresses return reflections into the fiber (col. 4 lines 20-24),” and then concludes that “... it would have been obvious ... to modify the optoelectronic module disclosed by Tonai such that the optical component had a first facet and a second facet parallel to one another, as is taught by Blair, in order to further prevent optical signals which are internally reflected within the optical component from entering into the terminal end of the optical fiber (reduce return reflection).”

Notwithstanding the contentions of the Examiner, Applicant notes that the passage cited by the Examiner, namely, col. 4, lines 20-24 of *Blair*, admits of an interpretation quite different from that advanced by the Examiner in the Office Action. Particularly, that passage states “... optical fiber 14 in inserted into ferrule 20 so that glass core 15 butts against spacer 35, which substantially reduces or suppresses return reflections.” *Col. 4, lines 20-24*. In contrast with the assertion of the Examiner, it appears that the aforementioned passage is suggesting that it is the particular arrangement/disposition of the components, rather than the specific components themselves, that provides suppression of return reflections. That is, the aforementioned passage from *Blair* seems to suggest that return reflections are substantially reduced or suppressed because glass core 15 butts against spacer 35. Thus, it does not appear from the cited passage that the spacer 35, itself, performs any reduction or suppression of return reflections.

Notwithstanding the contentions of the Examiner then, it does not appear that the spacer 35 of *Blair* performs the functions attributed to it by the Examiner. Thus, even if *Blair* and *Tonai* are combined in the purportedly obvious fashion, the resulting combination fails to include all the limitations of the rejected claims. It is likewise evident that there would be no motive to include the spacer 35 of *Blair* in the *Tonai* device, insofar as that spacer 35 does not perform the functions attributed to it by the Examiner.

The rejection posed by the Examiner is problematic for at least one other reason as well. In particular, the Examiner has asserted that it would have been obvious ... to modify the optoelectronic module disclosed by Tonai such that the optical component had a first facet and a second facet parallel to one another ... in order to further prevent optical signals which are internally reflected within the optical component from entering into the terminal end of the optical fiber (reduce return reflection).” *Emphasis added*. However, *Tonai* discloses that “... the tilted exit end face 33 prevents the reflected light at the light emitting face 33 from returning to the end face 50b [of optical fiber 50]. The tilted surface can

restrain the reflected light from returning back through the optical fiber 50 to the optical transmitter ...”

Paragraph 0065. Emphasis added.

In view of the fact that *Tonai* purports to offer a solution to the problem of back reflection, one of skill in the art would have no motive to modify the *Tonai* device to include the “spacer 35” of *Blair*.

In light of the foregoing discussion, Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness with respect to independent claims 1, 9 and 20, at least because the Examiner has not established the existence of a motivation to combine the purported teachings of the references, and because even if the references are combined, the resulting combination fails to include all the limitations of the rejected claims. Applicant thus submits that the rejection of claims 1, 9 and 20 should be withdrawn. Inasmuch as dependent claims 2-8, 11-19 and 21-24 all require “...the optical component having a first facet and a second facet that are parallel to each other...,” the rejection of those claims should likewise be withdrawn.

III. New Claim 25

By this paper, Applicant has added new independent claim 25. Applicant respectfully submits that, consistent with the discussion presented herein, new claim 25, which is directed to a transceiver that includes, among other things, “an optical component having a first facet and a second facet, the second facet being parallel to the first facet,” is patentably distinct from the devices purported by the Examiner to be disclosed in the references that the Examiner has cited. In this connection, Applicant respectfully notes that reference to the aforementioned exemplary limitation is not intended, nor should it be construed, to be either an admission or assertion by the Applicant that patentability of Applicant’s new claim, or any other claims, hinges on the presence of such limitation. Rather, Applicant submits that each of the now pending claims, considered in its respective entirety, patentably distinguishes over the reference cited by the Examiner.

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CONCLUSION

In view of the remarks submitted herein, Applicant respectfully submits that each of the pending claims 1-25 is now in condition for allowance. Therefore, reconsideration of the rejections is requested and allowance of those claims is respectfully solicited. In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate the same with the undersigned attorney.

Dated this 16th day of December, 2005.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Peter F. Malen, Jr.", with a long horizontal flourish extending to the right.

Peter F. Malen, Jr.
Attorney for Applicants
Registration No. 45,576
Customer No. 022913
Telephone No. (801) 533-9800